

REMARKS

Claims 1-54 are pending in the application.

Claims 1-30, 32-45 and 49-54 have been rejected.

Claim 31 has been allowed.

Claims 46-48 have been objected to.

Claims 1, 12, 18, 21, 32-34, 39, 42, 45 and 54 have been amended, as set forth herein.

Claims 10-11, 19-20 and 43-44 have been canceled, without prejudice.

New Claims 55-60 have been added.

I. ALLOWABILITY OF CLAIM 31 AND OBJECTION TO CLAIMS 46-48

Applicant thanks the Examiner for the indication that Claim 31 is allowed and that Claims 46-48 are objected to but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. At this time, Applicant is not rewriting these claims in independent form.

II. DRAWINGS

The drawings were objected to because of missing or incorrect reference numerals. Applicant is submitting a proposed drawing change for approval that corrects the noted deficiencies.

III. CLAIM OBJECTIONS AND REJECTION UNDER 35 U.S.C. § 112

Various claims were objected to and rejected under 35 U.S.C. § 112, second paragraph. Applicant has amended Claims 32, 39 and 42 to correct the noted informalities. Accordingly, the Applicant respectfully requests withdrawal of the claim objections and the § 112 rejection.

IV. REJECTION UNDER 35 U.S.C. § 102

Claims 1-9, 16, 18 and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ford (US 6,463,051).¹ The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Independent Claims 1, 18 and 32 have been amended to recite that the interoperation functional unit (Claims 1 and 32) and the gateway adaptor (Claim 18) is responsive to communication control data from a remote network services unit operable for providing call

¹ The Office Action rejection based on Ford refers to “102(b)”, however Applicant assumes that this rejection is based upon “102(e).”

processing services for a call session involving the PBX system entity. Ford fails to disclose this feature/element.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102 rejection of Claims 1-9, 16, 18 and 32.

V. REJECTION UNDER 35 U.S.C. § 103

Claims 10-15, 17, 19-30, 33-45 and 49-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford (US 6,463,051) in view of Chimura (EP 0881812). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d

1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As noted in the preceding section addressing the 102 rejection, independent Claims 1, 18, 32, as well as dependent Claim 34, each recite that the interoperation functional unit (or gateway adaptor) is responsive to communication control data from a remote network services unit operable for providing call processing services for a call session involving the PBX system entity, while Ford fails to disclose these elements/features.

The Office Action argues, with respect to various dependent claims, that Chimura discloses such features/elements and identifies Chimura's DNS server 16 as being the remote network services unit of Applicant's invention. Applicant respectfully submits that Chimura's gateway 12, 14 are not responsive to communication control data from the DNS server 16

operable to provide call processing services for a call session. The gateways of Chimura utilize the DNS server 16 as a lookup table to determine the IP addresses of the destination gateway based upon the destination address (or host name) input by the source telephone terminal. Upon receiving the IP address of the destination gateway, the source gateway then performs the call processing services (e.g., call connection request, connection response, etc.). Col. 7, lines 28 thru Col. 8, line 52 and FIGURE 6; Col. 9, line 55 thru Col. 11, line 24 and FIGURE 7. In either embodiment described, the DNS server receives an IP address look-up request, determines the IP address, and returns the IP address of the destination gateway to the source gateway - no further function is described. As such, the DNS server 16 of Chimura does not disclose, teach or suggest that the interoperation functional unit (or gateway adaptor) is responsive to communication control data from the a remote network services unit that is operable to provide call processing services for a call session. No communication control data for call processing services are received at the gateways of Chimura. The DNS server 16 merely looks up an IP address.

Therefore, the combination of Ford and Chimura fail to disclose, teach or suggest the Applicant's invention as claimed in independent Claims 1, 18 and 32 (and their dependent Claims) and dependent Claim 34 (and its further dependent claims).

With respect to independent Claims 33 and 54, Ford fails to disclose a network interface for exchanging signals with a remote network services unit through a packet switched network. No remote network services unit appears to be disclosed by Ford. Further, Ford's interface card 20 does not appear to exchange signals through the packet switched network. Neither Ford nor

Chimura discloses implementing a device emulator to make the apparatus behave toward the remote network services unit as a telephone terminal of a second type, where the telephone terminal of the first type is different from the telephone terminal of the second type.

However, to further prosecution and clarify the Applicant's invention, independent Claims 33 and 54 have been amended to recite that the second type of telephone terminal (and means) are operable to interact with the remote network services unit. As such, the second type of telephone terminals are operable to interact with the remote network services unit, the first type are different from the second type, and therefore the device emulator makes the apparatus behave like a telephone terminal of the second type (which is operable with the remote network services unit). Neither Ford nor Chimura, alone or in combination, disclose, teach or suggest the Applicant's invention as claimed in independent Claims 33 and 54.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections of Claims 10-15, 17, 19-30, 33-45 and 49-54.²

VI. NEW CLAIMS 55-60

Applicant has added new Claims 55-60. Applicant respectfully submits that these new Claims further define over the cited references.

² For the same or similar reasons set forth herein, Claims 17, 30 and 53 are patentable over the Ford-Chimura-Korpi combination.

VII. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 10/8/2004


Robert D. McCutcheon
Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: rmccutcheon@davismunck.com